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| 10/563,517      | 04/06/2006  | Daniel Thomas Murphy | 4046-040            | 8630             |

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| EXAMINER |
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BASINGER, SHERMAN D

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| ART UNIT | PAPER NUMBER |
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3617

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07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/563,517

Applicant(s)

MURPHY ET AL.

Examiner

Sherman D. Basinger

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-20,22,23,25,27-41 and 43-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-20,22,23,25,27-41 and 43-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/6/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. The preliminary amendment filed January 5, 2006 has been received.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 121 of figure 6 and 211, 213, 217, 219 and 221 of figures 7 and 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The abstract of the disclosure is objected to because legal phraseology such as means has been used in the abstract. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

4. Claim 19 is objected to because of the following informalities: the non-engaging faces has no clear antecedent. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 5, 7-11, 14, 23, 43, 45-50, 25, 30-34 and 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 052 783.

For claim 1 EP 783 discloses a sports board comprising a main portion 1 or 2 and an edge portion 1 or 2, the edge portion being separable from the main portion, the edge portion being engageable

with the main portion, the edge portion in use to provide an edge profile, upper

surface

and lower surface which is an substantially uninterrupted continuation of the edge

profile upper surface and lower surface respectively of the main portion, a connection

means providing the interengagement between the main portion and the edge portion

to prevent relative movement between the edge portion and the main portion when

engaged, the connection means 4a and 5a being able to withstand the forces anticipated to be

exerted between the edge portion and main portion during use of the sports board, the

edge of the main portion which in use is to abut the edge portion having a generally

convex profile 5 and the edge of the edge portion which in use is to abut the main

portion having a complementary generally concave profile 4.

The fastening means, the first engagement portion and the second engagement portion of claim 4 are 6, 4 and 5 of EP 783.

The complementary formations of claim 6 are 4 and 5 of EP 683.

The groove is 5a and the tongue is 4a.

The board of EP 783 is considered to be a surfboard, sailboard, wakeboard, kite-surfing board and wave ski because these are intended uses of the board and the board of EP 783 can perform each of these uses.

As shown in the figures of EP 783 the abutting edge portion and main portion have an extent which is non-linear and symmetrical about the central axis between the main portion and edge portion. Also as shown in figures 1 and 2 of EP 783 the configuration is defined by a set of interconnected straight edges.

Note that fastening means 6 is located in the region of the interengagement and that the channel and groove are formed to provide the fastening means in part.

For claim 5, EP 783 discloses a connection means adapted to enable the engagement of an edge portion 1 or 2 to a main portion 1 or 2 of a sports board, the connection means 4 and 5 configured to extend along at least a portion of the edge of the main portion and comprising a pair of interengagable portions 4 and 5 which are capable of connecting the main portion with the edge portion such that the edge portion is capable of engagement with the main portion, the connection means providing the interengagement between the main portion and the edge portion to prevent relative movement between the edge portion and the main portion when engaged, the connection means being able to withstand the forces anticipated to be exerted between the edge portion and main portion during use of the sports board.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 783 in view of Oliver.

EP 783 does not disclose that a plurality of edge portions are provided which are each capable of being separately engaged with the portion of the edge to provide a capacity for a variation in shape for the sports board. Note the plurality of edge portions 1, 2, 3a and 3b of Oliver. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to provide a plurality of edge portions 2 of EP 783 of various shapes for the sports board in view of the teachings of Oliver. Motivation to do so is to provide for a different look and operation of the sports board of EP 783.

9. Claims 6, 19, 20, 22, 15-17, 27-29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 783 in view of Galich.

EP 783 does not disclose that the engagement portions 4 and 5 of are formed as separate elements which are to be incorporated into the respective edge portion and main portion during formation of the main portion and the edge portion. Note the engagement portions 16 and 18 of Galich. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to follow the teachings of Galich and have the engagement portions 4 and 5 of EP 783 be formed as separate elements which are to be incorporated into the respective edge portion and main portion during formation of these portions. Further, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to replace the fastening means of EP 783 with fastening means similar to 54, 58, 60, 50 and 52 of Galich. Motivation to do so is this would allow a stronger material to be used to make the engagement portions than is used to make the sports board.

The extension portion of claims 19 and 29 would be similar to 26 and 32 of Galich.

With regard to claim 17, the fixings which are engageable with the engaged engagement portions would be similar to 58, 54, 50 and 52 of Galich.

The first and second engagement portions of claim 27 would be similar to 16 and 18 of Galich.

10. Claims 12, 13, 44 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 783 in view of Kolstad.

The configuration of the faces of the edge portion and the main portion which are in abutting relationship when interengaged are not arcuate. Note the arcuate faces of the interengaged edge portions of the sports board of Kolstad. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make the configuration of the faces of EP 783 arcuate in view of the teachings of Kolstad. Motivation to do so is to make them less blunt to avoid injury.

In making the faces arcuate the configuration of 4a and 5a of EP 783 becomes generally sinusoidal.



11. Claims 18 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 783 and Galich as applied to claim 6 above, and further in view of Shurgot et al.

The combination of EPA 783 and Galich does not disclose that a plurality of fixings can be engaged at spaced locations along the interengaged faces of the engagement portions. Note the plurality of fixings 127 used by Shurgot et al. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use a plurality of fixings all similar to 54, 52 and 60 of Galich along the interengaged faces of the engagement portions provided in view of Galich to EPA 783. Motivation is to hold the main portion and edge portion more securely together.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 571-272-6679. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sherman Basinger/  
Sherman Basinger, PE  
Art Unit 3617

Friday, June 15, 2007